

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 28
EWH/JW

10/25/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Phillips Publishing International, Inc. and Phillips
Publishing, Inc.

v.

Internet World Broadcasting Corporation

Opposition No. 102,098
to application Serial No. 74/670,773
filed on May 8, 1995

Peter G. Mack for Phillips Publishing International, Inc.
and Phillips Publishing, Inc.

Eleanor Spillnan for Internet World Broadcasting
Corporation

Before Simms, Seeherman and Hanak, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Internet World Broadcasting Corporation (applicant)
seeks to register in typed drawing form INVESTOR WORLD
for "providing access to an on-line computer database and
bulletin board service featuring advertisement and

Opposition No. 102,098

marketing information for investment products and services offered to users of a global computer network; on-line computerized ordering of investment products and services." The intent-to-use application was filed on May 8, 1995.

Phillips Publishing International, Inc. and its wholly owned subsidiary Phillips Publishing, Inc. (referred to simply as "opposer") filed a notice of opposition alleging that since at least as early as August 1993, they used the marks INVESTOR'S WORLD and JOHN DESSAUER'S INVESTOR'S WORLD as trademarks for a financial newsletter. Continuing, opposer alleged that should applicant commence use of its service mark INVESTOR WORLD, consumers would be "likely to be misled into believing, contrary to fact, that applicant's services ... emanate from or are in some way sponsored by opposer." (Notice of opposition paragraph 10). While the notice of opposition did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the ground upon which the opposition is based. Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Opposer made of record a substantial body of evidence which is summarized at page 9 of its brief. Applicant did not make if record

Opposition No. 102,098

evidence or file a brief. Neither party requested a hearing.

At the outset, we note that priority rests with opposer. In this regard, opposer has properly made of record a certified status and title copy of Registration No. 1,873,792 (owned by Phillips Publishing International, Inc.) depicting in typed drawing form the mark JOHN DESSAUER'S INVESTOR'S WORLD for a financial newsletter. This registration issued on January 17, 1995 with a claimed first use date of August 6, 1993. More importantly, the record reflects that continuously since August 1993, opposer has also used the trademark INVESTOR'S WORLD per se for its newsletter. From the very beginning, opposer has depicted what is shown below at the very top of the first page of each of its monthly financial newsletters.

As is readily apparent from viewing the above, the words INVESTOR'S WORLD are not only depicted in lettering far larger than that used for JOHN DESSAUER'S, but in addition, the words INVESTOR'S WORLD are depicted on a separate line. Such manner of depiction causes

Opposition No. 102,098

INVESTOR'S WORLD to function as a trademark by itself. Moreover, throughout the text of opposer's financial newsletter, the newsletter is repeatedly referred to as simply INVESTOR'S WORLD, and not as JOHN DESSAUER'S INVESTOR'S WORLD. In addition, opposer's financial newsletter has received favorable mention in general business magazines such as Forbes and in publications which "rank" financial newsletters such as The Hulbert Financial Digest. These publications refer to opposer's financial newsletter as simply INVESTOR'S WORLD. Finally, when subscribers communicate with opposer, they almost always refer to opposer's financial newsletter as simply INVESTOR'S WORLD.

Opposer's INVESTOR'S WORLD financial newsletter has enjoyed considerable success since its launch in August 1993. Since 1993, paid subscriptions for this newsletter have exceeded \$50 million. In addition, opposer has spent nearly \$19 million in advertising and promoting its INVESTOR'S WORLD financial newsletter. Currently, there are over 100,000 subscribers to INVESTOR'S WORLD, making it the largest selling financial newsletter that costs more than \$100 per year. This success is due in part to the performance of the stocks, bonds and other financial vehicles recommended in INVESTOR'S WORLD financial

Opposition No. 102,098

newsletter. In 1996 and again in 1997, The Hulbert Financial Digest ranked INVESTOR'S WORLD first in the total rate of return on a risk-adjusted basis when compared to over 20 other financial newsletters.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, we will focus on a comparison of opposer's mark INVESTOR'S WORLD with applicant's mark INVESTOR WORLD because, obviously, opposer's other mark (JOHN DESSAUER'S INVESTOR'S WORLD) is less similar to applicant's mark. As is readily apparent, the only difference between opposer's mark and applicant's mark is that opposer's mark places the word INVESTOR in the possessive form, whereas applicant's mark does not. However, this very minor difference does very little to distinguish the two marks in terms of visual appearance, pronunciation or meaning. In short, we find

Opposition No. 102,098

that the two marks are almost identical. Thus, the first Dupont "factor weighs heavily against the applicant" because the two word marks are almost identical. In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of opposer's goods and applicant's services, we note that because the marks are almost identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in point of fact, the record demonstrates that opposer's financial newsletter and applicant's on-line investment services are closely related to the point of being directly competitive. Indeed, the only difference is not in the message, but merely in the medium.

Applicant's president acknowledged that a "reader" of applicant's on-line INVESTOR WORLD is someone who is looking for investment advice and who is paying applicant. (J. Tollefsen deposition page 25). Obviously, readers of opposer's INVESTOR'S WORLD financial newsletter are also looking for investment advice. Indeed, applicant's president acknowledged that

Opposition No. 102,098

the quality of opposer's INVESTOR'S WORLD financial newsletter is such that if opposer were to make available an on-line version of said newsletter, applicant would include it, if permitted, on its INVESTOR WORLD website. (J. Tollefsen deposition page 35). In this regard, applicant's vice president noted that the customer base for applicant's INVESTOR WORLD on-line investment services is so broad that it encompasses "anyone who is interested either in investing, or wanting some information about investing. It could be anybody." (D. Tollefsen deposition page 16).

If there is any lingering doubt about the very close relationship of opposer's financial newsletter and applicant's on-line investment services, such doubt is eliminated in light of the substantial evidence showing that virtually every financial newsletter, magazine and newspaper has in recent years introduced an on-line version of said newsletter, magazine and newspaper utilizing the same trademark, albeit sometimes preceded or followed by the generic term "on-line" or some other similar generic term. Indeed, applicant's president acknowledged that a number of print publications in the financial area have gone "on-line," and that there is a clear trend among virtually all financial print

Opposition No. 102,098

publishers to go on-line. (J. Tollefsen deposition pages 38 and 66). Simply by way of example, the following print publications offer on-line versions under the same or essentially the same marks: The Wall Street Journal, Barron's, Business Week, Forbes, Fortune, Kiplinger's Personal Financial Magazine and Worth. Indeed, opposer itself now offers an on-line version of its INVESTOR'S WORLD financial newsletter under the name INVESTOR'S WORLD ONLINE. (Present deposition page 10). (As an aside, we have not considered opposer's common law rights in the mark INVESTOR'S WORLD ONLINE for an on-line financial advisory service because opposer has not established that such common law rights predate applicant's constructive use filing date of May 8, 1995.)

In sum, given the fact that opposer's mark INVESTOR'S WORLD and applicant's mark INVESTOR WORLD are almost identical and the fact that the parties market investment advice to the very same consumers, albeit through different mediums, we find that there exists a likelihood of confusion resulting from the contemporaneous use of these two marks.

Decision: The opposition is sustained.

R. L. Simms

E. J. Seeherman

E. W. Hanak
Administrative

Trademark

Judges, Trademark Trial
and Appeal Board